

Atty. Docket No. YOR920030045US1
(590.104)

REMARKS

The fact that August 19, 2006, fell on a Saturday ensures that this paper is timely filed as of Monday, August 21, 2006, the next business day.

In the Office Action dated April 19, 2006, pending Claims 1-3 and 5-19 were rejected and the rejection made final. Claims 10-19 were previously withdrawn from consideration. Claim 1 is independent and the remaining claims are dependent. In response Applicants have filed herewith an Amendment After Final and have rewritten independent Claim 1 and dependent Claim 3, and cancelled dependent Claim 4.

Claim 3 has been amended only for the purposes of consistency and to correct a minor typographical error. Claim 4 contained a three element markush group, in which only one of the three elements was used in the rejection of the claim. Claim 1 has been rewritten to, *inter alia*, partially incorporate the subject matter of Claim 4, i.e., the two elements to which the Office did not previously object. Applicants intend no change in the scope of the claims by the changes made by this amendment. It should be noted these amendments are not in acquiescence of the Office's position on allowability of the claims, but merely to expedite prosecution.

Rejection of claims 1-9 under 35 U.S.C. § 103(a) over Hurst in view of Daughton:

Claims 1-9 stand rejected as being unpatentable over U.S. Patent 5,956,267 to Hurst et al. (hereinafter Hurst) in view of U.S. Published Application 2004/0023065 of Daughton et al. (hereinafter Daughton) under 35 U.S.C. § 103(a).

Atty. Docket No. YOR920030045US1
(590.104)

As best understood, Hurst is directed to a self-aligned wordline keeper and method of manufacture therefore. The wordline structure acts to conduct and generate a magnetic field and comprises first and second side surfaces and a plurality of layers, including a soft magnetic field layer (30, 122) that can be formed from NiFeCo (Figures 9-13 & 16, col. 5 lines 26-36, and col. 7 lines 6-14). Hurst does not teach or suggest that the soft magnetic field layer has super-paramagnetic properties.

As best understood, Daughton is directed to magnetic field sensors having a magnetic field sensing structure comprising a "layer" (12') of NiFeCo having super-paramagnetic properties (Figures 5A, 5B & 6, ¶ [0079]). The "layer" (12') of super-paramagnetic NiFeCo is actually a plurality of platelets deposited onto a conducting buffer layer (11'') via sputter deposition (¶¶ [0075] & [0079]).

According to the Examiner it would have been obvious to one of ordinary skill in the art to modify the device of Hurst to use NiFeCo having super-paramagnetic properties in the soft-magnetic layer, as taught by Daughton due to the advantageous properties of such a material disclosed by Daughton.

Applicants respectfully submit that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations.

Atty. Docket No. YOR920030045US1
(590.104)

MPEP § 2143. The teachings of a prior art reference must be considered as a whole including those portions that would lead away from the claimed invention. MPEP § 2141.02(VI).

Claim 1, as amended, recites that the magnetic layer comprises a ferromagnetic film that is either a "spin-on film made out of ferromagnetic particles in a high thermal stability polymer" or "evaporated multilayer films made out of repeated layers of Terbium and ferromagnetic particles." At best, Daughton teaches that the super-paramagnetic "layer" is a film of platelets made through sputter deposition (¶¶ [0075] & [0079]). Applicants respectfully submit that neither Hurst nor Daughton teach or suggest a super-paramagnetic magnetic liner that comprises a ferromagnetic film that is either a "spin-on film made out of ferromagnetic particles in a high thermal stability polymer" or "evaporated multilayer films made out of repeated layers of Terbium and ferromagnetic particles." Continued rejection of Claim 1 on these grounds would therefore be improper.

For the foregoing reasons, Applicants respectfully submit that Claim 1, as amended, is allowable over Hurst and Daughton. Applicants respectfully request that the Examiner withdraw the rejection of claim as being unpatentable over Hurst in view of Daughton under 35 U.S.C. § 103(a).

With regards to the rejection of claims 2, 3, and 5-9 these claims are dependent upon independent claim 1. Applicants respectfully submit that these claims are allowable over Hurst and Daughton for at least the same reasons as discussed above with regards to claim 1. Applicants respectfully request that the Examiner withdraw the rejection of

Atty. Docket No. YOR920030045US1
(590.104)

claims 2, 3, and 5-9 as being unpatentable over Hurst in view of Daughton under § 103(a).

Response After Final:

Applicant respectfully submits that the current Amendment After Final presents no new issues of patentability since the Examiner has already addressed the subject matter of claim 4, which has been partially incorporated into independent claim 1 by this Amendment After Final and as such the current amendment may be properly entered by the Examiner under 37 C.F.R. § 1.116. Applicant respectfully requests that the Examiner enter and consider the current amendment.

In view of the foregoing, it is respectfully submitted that claim 1 fully distinguishes over the applied art and is thus in condition for allowance. It is also respectfully submitted that dependent claims 2, 3, and 5-9 are also in condition for allowance.

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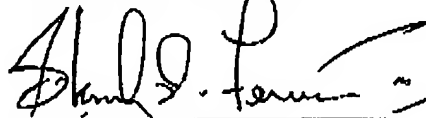
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Atty. Docket No. YOR920030045US1
(590.104)

In summary, claims 1-3 and 5-9 are fully distinguishable over the applied art and immediately allowable. Notice to that effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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